

**REMARKS**

Claims 1-16 and 30 are pending. By this Amendment, claims 1, 2 and 4 are amended. Reconsideration in view of the above amendments and following remarks is respectfully requested.

**I. THE CLAIMS MEET THE REQUIREMENTS OF 35 U.S.C. §112**

The Office rejects claims 1-16 and 30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which the application regards as the invention. The rejection is respectfully traversed.

With respect to claims 1-16, the Office asserts that inclusion of the term “wherein” “raises a question as to the limiting effect of the language in the claim.” According to MPEP §2111.04,

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

(A) "adapted to" or "adapted for" clauses;

(B) "wherein" clauses; and

(C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.'" *Id.*

Thus, according to the MPEP, determining whether the term “wherein” makes the term

optional or whether it is limiting “depends on the specific facts of the case.” In this case, Applicant suggests that the usage of the term “wherein” is clear and that it is used to further define the term “global debt service.”

With respect to claims 2 and 4, Applicant submits that those claims as amended overcome the rejection under 35 U.S.C. §112.

With respect to the usage of “its” in claim 2, Applicant suggests that the term “its” refers to “a financial institution” and thus, there is suitable claim antecedent basis for this term.

In view of the above comments and amendments to claims 2 and 4, Applicant respectfully requests withdrawal of the rejection of claims 1-16 and 30 under 35 U.S.C. §112.

## **II. CLAIMS 1-16 AND 30 DEFINE PATENTABLE SUBJECT MATTER PURSUANT TO 35 U.S.C. §103**

The Office Action rejects claims 1-16 and 30 under 35 U.S.C. §103 as being unpatentable over U.S. Patent Publication No. 20030065614 to Sweeney (“Sweeney”) in view of U.S. Patent Publication No. 20020116323 to Schnall (“Schnall”). The rejection is respectfully traversed.

The Office Action asserts that Sweeney demonstrates the following: providing business identification information; providing business credit information; providing information regarding sources and uses of loans; and providing cash flow information. The Office Action also asserts that “Sweeney is involved in an automated underwriting decision based on information gathered from an entity based upon cash flow (as well as other) considerations. It is clear that Sweeney also attempts to integrate these considerations among the business entity as well as personal entities comprising the business.”

The Office Action also asserts that Schnall seeks to consolidate information of both business and personal entities in order to determine loan eligibility, including total debt and total income.

Neither Sweeney nor Schnall discloses performing a risk assessment based upon net profit depreciation data, net cash flow, current debt and proposed debt, as recited in claim 1 of

Applicant's invention. The system of Sweeney is only directed to rules based underwriting where an underwriter's website includes webpages for a multiscreen loan application. After determining a credit score, the system in Sweeney sends the score to loan product identifier to determine which type of loan an applicant may be eligible to receive. Once the loan product is identified, a term sheet identifier may send the results to the applicant.

Schnall is directed to a method and apparatus for providing loan information to multiple parties. The system and method of Schnall provides loan data made to a primary party where the loan has a secondary party.

Neither Sweeney nor Schnall provides the features of the Applicant's invention, for example, performing a risk assessment based upon net profit depreciation data, net cash flow, current debt and proposed debt, as recited in claim 1. Therefore, the combination of Sweeney and Schall fails to teach or suggest the Applicant's invention as recited in claim 1. Therefore, withdrawal of the rejection of claim 1 under 35 U.S.C. §103 is respectfully requested. Furthermore, withdrawal of the rejection of dependant claims 2-16 and 30 under 35 U.S.C §103 is requested for the reasons described above and for the additional features which those claims recite.

## Conclusion

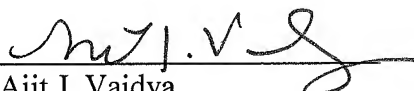
Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If the patent examiner believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, they are invited to call on the number below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account listed on Applicant's initial application filing transmittal document.

Respectfully submitted,

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